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09/930,207	08/16/2001	Takeshi Hoshino	500.40519X00	9219

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EXAMINER
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NGUYEN, CHANH DUY

ART UNIT	PAPER NUMBER
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2675

/8

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/930,207

Applicant(s)

HOSHINO ET AL.

Examiner

Chanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 9,10 and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 11-12 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on February 17, 2004 has been entered and considered by examiner.

### ***Election/Restrictions***

2. Applicant's election with traverse of the election Species of Figures 2a-2B in Paper No. 9 is acknowledged. The traversal is on the ground(s) that (start at page 11, line 12 of the Remarks) "the examiner attention is directed to the requirements for restriction which must include a showing that two or more inventions are in fact independent and distinct as set forth MPEP 806.04 thought 806.04(1). There are several grounds identified for holding that restriction to a single elected species is necessary. For example, different sub-combinations useable together in a single combination, product and process inventions, etc. At no point in the Office Action has the examiner made such allegation". This is not found persuasive because the election species does not require identify combination-subcombination, different sub-combinations useable together in a single combination, product and process inventions, etc. as the restriction requirement. It appears that applicant completely confused between the requirement of the election species and the restriction.

MPEP 809.02(a) (B) simply requires that "Action as follows should be taken:  
(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III,

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respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted". In this case, examiner clearly identify the species of Figures as requirement by MPEP 809.02(a). Applicant further argues that Figs.5a-f simply illustrate the details of sub-feature of the invention which do not rise to the level of a species as alleged by the examiner. However, even Figs. 5a-f are sub feature of the invention, but each of Fig.5a-f is patentability distinct from each others.

The application contains claims directed to a plurality of disclosed patentability distinct species. Thus, claims 9-10, 13-18 are withdrawn from the consideration because the limitations a first condensing lens, second condensing lens as well as the limitation first focal distance, second local distance are directed to Species of Figure 24, and the limitation and structured to operated one of operation switches is directed to species of Figures 7A-7B. Figure 2A disclose only one switch (5) while species of Figure 7A-B discloses two switches or operation switches (5 and 15).

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

4. The references JP-A -7-219702 and JP-A-8-179878 submitted under 37 CFR 1.56 9 have been considered, but the form PTO-1149 has not been submitted so that all the reference can be initialed and signed the form by examiner.
5. The references listed on the Information Disclosure Statement filed on February 21, 2003 have considered by examiner; see attached PTO-1449.

***Drawings***

6. The drawings are objected to because page 21, line 28 discloses two Figs. 7 (i.e. Fig. 7A and Fig.7B). However, the drawings only show single Fig. 7 . A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

7. The disclosure is objected to because of the following informalities: Page 9, line 5 of the specification discloses a single Fig.7, but page 21, line 28 discloses two Figures 7: Fig. 7A and Fig. 7B..

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-4 and 11-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bjorn (WO 00/16244).

Bjorn discloses the prior art most closely resembling the subject matter of the claims 1-4 and 11-12.

10. Claims 1-4 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Sayag (U.S. Patent No. 6,166,370).

As to claim 1, Sayag discloses a pointing device (100) for moving a pointer (120) shown on a display screen (118) including a transparent plate (104) having an outer surface to contact a surface of an object (102). Sayag teaches an image detecting means(110) for detecting an image of the surface of the object that contacts an outer surface of the plate (104); and optical means (108) for forming an image on the outer

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surface of the plate on a detection plane of the image detecting means (110), wherein said pointer is configured to be able to move according to a movement of the image on the outer surface of said plate detected by the image detecting means (see column 5, line 40 through column 6, line 49).

As to claim 11, this claim differs from claim 1 only in that the limitations "light emitting means" and "control means" are additionally recited. These limitation are clearly taught by Sayag. For example, Sayga teaches a light emitting means (106) and controls means (110 and 114) as recited in the claim; see column 6, lines 1-39 and column 10, lines 44-55.

As to claim 2, Sayag clearly teaches means (e.g., serial data interface 114) for detecting a movement of said image detected by said image detecting means (110) and moving the pointer (120) in a direction according to the direction of said detected movement (see column 6, lines 23-39 and see column 10, lines 44-48).

As to claims 3 and 12, Sayag teaches means for determining a presence/absence of movement of the image on the outer surface of the plate detected by said image detecting means and switching a sensing frequency of said image detecting means according to the determination result (see column 5, lines 55-60, column 8, lines 55-65 and column 10, lines 13-25).

As to claim 4, Sayag teaches light emitting means (106) for emitting light onto the outer surface of the plate (104).

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***Allowable Subject Matter***

11. Claims 5-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 9-10 and 16-18 are dependent on claim 5, thus they are also rejoined if claim 5 is rewritten in independent form including all of the limitations of the base claim.12

**Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanh Nguyen whose telephone number is (703) 308-6603.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9306**

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

cm

C. Nguyen

April 30, 2004

  
CHANH NGUYEN  
PRIMARY EXAMINER